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JW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

YVONNE NG

Serial No.: 09/538,767

Filed: March 30, 2000

For: SYSTEM AND METHOD FOR MANAGING A
PLURALITY OF LOCAL LISTS OF A SINGLE USER

Group Art Unit: 2876

Examiner: S. Lee

Attorney Docket No.: 1697 (USW 0562 PUS)

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APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
U.S. Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is an appeal brief from the final rejection of claims 1-2, 7-13 and 18-24 of the Office Action mailed September 10, 2003. This application was filed on March 30, 2000. This is a revised appeal brief in response to the notice of non-compliance mailed on August 23, 2004.

I. REAL PARTY IN INTEREST

The real party in interest is Qwest Communications International Inc. The original assignment to US West, Inc. was recorded in the U.S. Patent and Trademark Office on March 30, 2000 at Reel 010713/Frame 0637. US West, Inc. merged with Qwest Communications International, Inc.

CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8

I hereby certify that this paper, including all enclosures referred to herein, is being deposited with the United States Postal Service as first-class mail, postage pre-paid, in an envelope addressed to: Mail Stop Appeal Brief - Patents, Commissioner for Patents, U.S. Patent & Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450 on:

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Name of Person Signing

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II. RELATED APPEALS AND INTERFERENCES

There are no appeals or interferences known to appellant, the appellant's legal representative, or assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 1-2, 7-13 and 18-24 are pending in this application. Claims 1-2, 7-13 and 18-24 have been rejected and are the subject of this appeal.

IV. STATUS OF AMENDMENTS

No amendments after final rejection have been filed.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The invention relates to a system and method for managing a plurality of local lists for a single user located at a plurality of remote appliances. Page 1, lines 4-5. Many products contain address books or similar lists that allow the user to keep names, telephone numbers, email addresses, bookmarks, and other personal contact information. These products do not all currently exist on the same network, nor are they all web enabled. A specific problem arises when a user uses some or all of these products for various purposes, namely, the user has no easy way of synchronizing and accessing the lists. Page 1, lines 7-14. Although each product, alone, may be quite useful, it becomes difficult and cumbersome for the user to manage multiple lists of information on different products. Although some attempts have been made to provide portable devices that can store information for a user, the management of these devices still, at times, becomes difficult. Page 1, lines 15-25. The invention provides a system and method for managing a plurality of local lists of a single user utilizing a compact user-carried smart card including a microprocessor and a memory storing a master list configured for synchronizing with each local list. Page 2, lines 5-8.

With reference to Figure 1, claim 1 recites a system 10 for managing a plurality of local lists of a single user. The plurality of local lists is located at a plurality of remote appliances 22, 24, 26, 28, 30, 32. Each appliance holds a corresponding local list and includes a card reader. Page 2, lines 9-12. System 10 comprises a compact user-carried smart card 12 including a microprocessor 14 and a memory 16 storing a master list. The master list is configured for synchronizing with each local list. Page 2, lines 12-14. The microprocessor 14 is programmed to synchronize the master list with a local list on a remote appliance 22, 24, 26, 28, 30, 32 when the smart card 12 is engaged with the remote appliance card reader to allow the user to carry the smart card with the master list stored in the smart card memory 16 to various remote appliances 22, 24, 26, 28, 30, 32 and synchronize the master list with the various local lists of the appliances. Page 2, lines 14-19. Page 5, lines 17-26. With reference to Figure 3, advantageously, the smart card 62 acts as a token for holding the master list for various local lists kept on various devices such as computer 66, set top box 70, telephone 80, laptop 84, personal digital assistant 86, or even a cellular telephone 88. Page 6, line 9-page 7, line 4. Claim 1 further recites that the list is composed of personal data entries including names, addresses, telephone numbers, and e-mail addresses. Page 3, lines 2-4.

With continuing reference to Figure 1, claim 11 recites a system 10 for managing a plurality of local lists of a single user. The system comprises a plurality of remote appliances 22, 24, 26, 28, 30, 32 for use on different networks. Each appliance holds a corresponding local list of the plurality of local lists. Each appliance includes a card reader. Page 3, lines 11-15. For example, as shown in Figure 3, computer 66 is connected to network 68, set top box 70 is connected to network 74, and telephone 80 is connected to network 82. Page 6, lines 9-21. As recited in claim 11, the system further comprises a compact user-carried smart card 12 including a microprocessor 14 and a memory 16 storing a master list. The master list is configured for synchronizing with each local list. Page 3, lines 15-17. The microprocessor 14 is programmed to synchronize the master list with a local list on a remote appliance 22, 24, 26, 28, 30, 32 when smart card 12 is engaged with the remote appliance card

reader. This allows the user to carry the smart card 12 with the master list stored in the smart card memory 14 to various remote appliances and synchronize the master list with the various local lists of the appliances. Page 3, lines 17-22. Page 5, lines 17-26. Claim 11 further recites that the list is composed of personal data entries including names, addresses, telephone numbers, and e-mail addresses. Page 4, lines 2-3.

With reference to Figure 2, claim 22 recites a method for managing a plurality of local lists of a single user. The method comprises storing a plurality of local lists on a plurality of corresponding remote appliances with each appliance including a card reader (block 42). A master list is stored on a compact user carried smart card including a microprocessor and a memory for storing the master list (block 44). The master list is configured for synchronizing with each local list. The microprocessor is programmed to synchronize the master list with a local list at a remote appliance when the smart card is engaged with the remote appliance card reader. Page 4, lines 4-12. Claim 22 further recites that the list is composed of personal data entries including names, addresses, telephone numbers, and e-mail addresses. Page 4, lines 2-3.

The remaining claims are dependent claims directed to additional features of the invention. In accordance with 37 C.F.R. § 41.37(c)(v), further explanation of these claims is not required.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Whether claims 1-2, 11-13 and 22-24 are unpatentable over Zanchi (U.S. Patent No. 5,633,484) in view of Detlef (U.S. Patent No. 6,178,403).

Whether claims 7 and 18 are unpatentable over Zanchi in view of Detlef further in view of Hamann (U.S. Patent No. 6,296,191).

Whether claims 8 and 19 are unpatentable over Zanco in view of Detlef further in view of Teicher (U.S. Patent No. 5,744,787).

Whether claims 9 and 20 are unpatentable over Zanco in view of Detlef further in view of Taylor (U.S. Patent No. 5,578,808).

Whether claims 10 and 21 are unpatentable over Zanco in view of Detlef further in view of Chen (U.S. Patent No. 5,694,471).

VII. GROUPING OF CLAIMS

Claims 1-2, 11-13 and 22-24 stand or fall together.

Claims 7 and 18 stand or fall together.

Claims 8 and 19 stand or fall together.

Claims 9 and 20 stand or fall together.

Claims 10 and 21 stand or fall together.

VIII. ARGUMENT

1. Claims 1-2, 11-13 and 22-24

The Examiner has rejected claims 1, 2, 11-13, and 22-24 under 35 U.S.C. § 103(a) as being unpatentable over Zanco (U.S. Patent No. 5,633,484) in view of Detlef (U.S. Patent No. 6,178,403).

Claim 1 recites, in combination with other features, that the system comprises “A compact user-carried smart card including a microprocessor and a memory storing a master list composed of personal data entries including names, addresses, telephone numbers, and e-mail addresses.” The smart card is further limited with the recitation of various structures and functions associated with the card.

Zancho does describe a method and apparatus for personal attribute selections and management using a preference memory. Zancho also describes a portable donor device 105 such as a smart card. Device 105 stores interface preferences such as, as acknowledged by the Examiner, fonts, menu order preferences, location of icons, etc. This functionality of Zancho is further evidenced by Figure 11 which depicts a preference selection matrix indexed by human senses, environment, and application device.

In contrast to the interface preferences of Zancho, claim 1 specifically recites that the master list is composed of personal data entries including names, addresses, telephone numbers, and e-mail addresses as opposed to merely containing interface preferences as suggested by Zancho. The Examiner has not pointed out any specific suggestion in Zancho that the donor device 105 may be used to store personal data entries including names, addresses, telephone numbers, and e-mail addresses as recited by claim 1. The Examiner has only noted that Zancho describes a donor device 105 storing interface preferences (font, menu order preferences, location of icons, etc.).

Detlef does describe a hand-held data acquisition device including a display presenting at least one of an address book, a date book, a memo pad, a to-do list, a contact manager, an expense tracker, an e-mail client, and a project manager, at least one of which contains multiple data items. Detlef further describes an input device operatively connected to the device suitable to receive voice data from the user. The data acquisition device of Detlef stores the voice data and associates the voice data with at least one of the data items.

But the invention as recited in the group of claims is believed to be patentable. There is no motivation to combine the references to achieve the claimed invention.

Zancho only describes a donor device storing interface preferences (font, menu order preferences, location of icons, etc.), as further evidenced by the Figure 11 matrix. There is no suggestion in Zancho of storing anything in the donor device other than interface preferences.

Turning to Detlef, Detlef fails to overcome this noted deficiency of Zancho. Detlef does describe a distributed voice capture and recognition system. However, Detlef fails to suggest modifying Zancho to incorporate a master list composed of personal data entries including names, addresses, telephone numbers, and e-mail addresses as recited by independent claims 1 and 11.

The Examiner states that a smart card could transfer information to the Detlef address book, and this would provide a convenience. But Detlef specifically describes a single hand-held device including a display presenting a variety of data items. The Detlef data acquisition device is only for associating voice data with at least one of the data items.

The arrangement of Detlef teaches away from the concept of the invention. The invention comprehends a master list configured to synchronize with each local list on a remote appliance to allow the user to carry the smart card with the master list stored in the smart card memory to various remote appliances, and synchronize the master list with the various local lists of the appliances. The invention advantageously allows the smart card to act as a token for holding the master list for various local lists kept on various devices wherein the master list is composed of personal data entries including names, addresses, telephone numbers, and e-mail addresses.

But in Detlef, a very different approach is taken in that a single hand-held device holds an address book, a date book, a memo pad, a to-do list, a contact manager, an expense tracker, an e-mail client, and a project manager. This is in direct contrast to the concepts of the invention as the invention allows the smart card to act as a token for holding the master list for various local lists kept on various devices. Detlef does no such thing and provides a single hand-held device. Although the Detlef devices does allow for data acquisition, the data acquisition is only for associating acquired voice data with at least one of the existing data items. In this arrangement, the only thing that Zanchi could provide is a preference matrix.

For these reasons, there is no suggestion to modify Zanchi in view of Detlef to achieve the claimed inventions, and claims 1-2, 11-13 and 22-24 are believed to be patentable.

2. Claims 7 and 18

The Examiner has rejected claims 7 and 18 over Zanchi in view of Detlef further in view of Hamann. These claims are dependent claims and are believed to be patentable.

3. Claims 8 and 19

The Examiner has rejected claims 8 and 19 as unpatentable over Zanchi in view of Detlef further in view of Teicher. These claims are dependent claims and are believed to be patentable.

4. Claims 9 and 20

The Examiner has rejected claims 9 and 20 as unpatentable over Zanchi in view of Detlef further in view of Taylor. These claims are dependent claims and are also believed to be patentable.

5. Claims 10 and 21


The Examiner has rejected claims 10 and 21 as unpatentable over Zanchi in view of Detlef further in view of Chen. These claims are dependent claims and are also believed to be patentable.

The appeal fee was paid in the first appeal brief filed February 14, 2002. The fee having been once paid, no further appeal fee is believed to be due. The Director is hereby authorized to charge \$110 for a one month extension of time to our Deposit Account No. 02-3978.

Please charge any additional fee or credit any overpayment in connection with this filing to our Deposit Account No. 02-3978.

Respectfully submitted,

YVONNE NG

By: 
Jeremy I. Curcuri
Registration No. 42,454
Attorney for Applicant

Date: October 25, 2004

BROOKS KUSHMAN P.C.
1000 Town Center, 22nd Floor
Southfield, MI 48075-1238
Phone: 248-358-4400
Fax: 248-358-3351

Enclosure - Appendix

IX. APPENDIX - CLAIMS ON APPEAL

1. A system for managing a plurality of local lists of a single user, the plurality of local lists being located at a plurality of remote appliances wherein each appliance holds a corresponding local list and includes a card reader, the system comprising:

a compact user-carried smart card including a microprocessor and a memory storing a master list composed of personal data entries including names, addresses, telephone numbers, and email addresses, the master list being configured for synchronizing with each local list, the microprocessor being programmed to synchronize the master list with a local list on a remote appliance when the smart card is engaged with the remote appliance card reader to allow the user to carry the smart card with the master list stored in the smart card memory to various remote appliances and synchronize the master list with the various local lists of the appliances.

2. The system of claim 1 wherein an access type of remote appliance is configured to display a list and includes a card reader, and wherein the microprocessor is further programmed to send the master list to the access type remote appliance for display thereon when the smart card is engaged with the remote appliance card reader of the access type remote appliance.

7. The system of claim 1 wherein at least one of the entries is an electronic bookmark.

8. The system of claim 1 wherein the memory also stores an electronic wallet.

9. The system of claim 1 wherein at least one of the entries is a password.

10. The system of claim 1 wherein the memory stores an encrypted smart card password to control access to the master list.

11. A system for managing a plurality of local lists of a single user, the system comprising:

a plurality of remote appliances for use on different networks wherein each appliance holds a corresponding local list of the plurality of local lists, and each appliance includes a card reader; and

a compact user-carried smart card including a microprocessor and a memory storing a master list composed of personal data entries including names, addresses, telephone numbers, and email addresses, the master list being configured for synchronizing with each local list, the microprocessor being programmed to synchronize the master list with a local list on a remote appliance when the smart card is engaged with the remote appliance card reader to allow the user to carry the smart card with the master list stored in the smart card memory to various remote appliances and synchronize the master list with the various local lists of the appliances.

12. The system of claim 11 wherein the plurality of remote appliances includes at least one access type of remote appliance configured to display a list and including a card reader, and wherein the microprocessor is further programmed to send the master list to the access type remote appliance for display thereon when the smart card is engaged with the remote appliance card reader of the at least one access type remote appliance.

13. The system of claim 11 wherein the plurality of remote appliances includes web-enabled appliances and non-web-enabled appliances.

18. The system of claim 11 wherein at least one of the entries is an electronic bookmark.

19. The system of claim 11 wherein the memory also stores an electronic wallet.

20. The system of claim 11 wherein at least one of the entries is a password.

21. The system of claim 11 wherein the memory stores an encrypted smart card password to control access to the master list.

22. A method for managing a plurality of local lists of a single user, the method comprising:

storing a plurality of local lists on a plurality of corresponding remote appliances, each appliance including a card reader; and

storing a master list composed of personal data entries including names, addresses, telephone numbers, and email addresses on a compact user-carried smart card including a microprocessor and a memory for storing the master list, the master list being configured for synchronizing with each local list, the microprocessor being programmed to synchronize the master list with a local list on a remote appliance when the smart card is engaged with the remote appliance card reader.

23. The method of claim 22 further comprising:

synchronizing the master list with at least one of the local lists.

24. The method of claim 22 wherein the plurality of remote appliances includes an access type of remote appliance configured to display a list and including a card reader, and wherein the method further comprises:

sending the master list to the access type remote appliance for display thereon when the smart card is engaged with the remote appliance card reader of the access type remote appliance.